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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,803	03/20/2000	Paul A. Freiberger	IR-003-C2	6272

21912 7590 07/30/2002

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LOS ALTOS, CA 94022

[REDACTED] EXAMINER

BRIER, JEFFERY A

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

2672

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

HGS

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/528,803	FREIBERGER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffery A. Brier	2672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 May 2002.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 68-82 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5) Claim(s) \_\_\_\_\_ is/are allowed.
  - 6) Claim(s) 68-82 is/are rejected.
  - 7) Claim(s) \_\_\_\_\_ is/are objected to.
  - 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3 &amp; 5</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

### ***Priority***

1. This application is a continuation of 09/372,399 which is a continuation of 08/620,641.

### ***Election/Restrictions***

2. Applicant's election without traverse of group I in Paper No. 9 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 68-82 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Each of independent claims 68 and 70 claims:

providing one or more sets of content data to the display device and/or to a content display system associated with the display device;  
providing to the display device and/or to the content display system a set of instructions for enabling the display device to selectively display, in an unobtrusive manner that does not distract a user of the display device and/or an apparatus associated with the display device from a primary interaction with the display device and/or apparatus, an image or images generated from a set of content data; and.

Due to the and/or term this claim is claiming:

providing one or more sets of content data to the display device and to a content display system associated with the display device;  
providing to the display device and to the content display system a set of instructions for enabling the display device to selectively display, in an unobtrusive manner that does not distract a user of the display device and an apparatus associated with the display device from a primary interaction with the display device and apparatus, an image or images generated from a set of content data; and.

Providing one or more sets of content data to the display device and to a content display system associated with the display device was not described in the originally filed specification. Similarly providing to the display device and to the content display system a set of instructions for enabling the display device to selectively display, in an unobtrusive manner that does not distract a user of the display device and an apparatus associated with the display device from a primary interaction with the display device and apparatus, an image or images generated from a set of content data was not described in the originally filed specification.

Each of independent claims 72, 74, 77 and 80 claims:

in an unobtrusive manner that does not distract a user of the display device and an apparatus associated with the display device from a primary interaction with the display device and apparatus, an image or images generated from a set of content data.

This was not described in the originally filed specification because when the user is interacting with an apparatus associated with the display device he would not be looking

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at the display, while the specification is directed to the times when the user is using the display.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 68-82 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4 and 18 of U.S. Patent No. 6,034,652. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending claims are broader than the patented claims. The following table correlates the pending claims with the patented claims.

Pending claims	Patented claims
68-69	1
70-71	18
72-73	2
74-82	4

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 68-71 and 74-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Gayraud et al., U.S. Patent No.

This reference teaches displaying a message out of the main axis of the user's attention.

Claims 68-71:

Gayraud audits the message when the timer event 710 of figure 7 causes the system to determine the current location of the cursor and the message being displayed, column 13 lines 18-22.

Claims 74-82:

These claims claim allowing the user to select control options while an image from the content data is displayed in an unobtrusive manner. Garyraud teaches this by allowing the user to select options via the File, Edit, Text, Drawing and Preferences button found in the menu bar or icons on the toolbar all at the top of Gayraud's screen as seen in figure 3A. The link of claims 76, 79 and 82 is very broadly claimed and covers the user of Gayraud's system selecting via the drop down menus, a drive to retrieve data.

9. Claims 68-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Rakavy et al., U.S. Patent No. 5,913,040.

Claims 68-71:

Rakavy retrieves content data (advertisements) from a server and sends statistics, applicants auditing, to the server (column 7 line 54).

Claims 72-73:

Rakavy displays the advertisements during an idle period (column 7 line 63 to column 8 line 3).

Claims 74-82:

Rakavy alternatively displays the advertisements in a manner that would not interfere with the user's attention while the user is viewing the display, column 3 lines 30-33.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (703) 305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713).

**Any response to this action should be mailed to:**

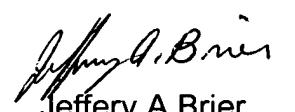
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



Jeffery A Brier  
Primary Examiner  
Art Unit 2672